



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,032	01/03/2001	Matthew P. Scott	CIBT-P10-203	2036

28120 7590 10/06/2003  
ROPES & GRAY LLP  
ONE INTERNATIONAL PLACE  
BOSTON, MA 02110-2624

EXAMINER

BRANNOCK, MICHAEL T

ART UNIT	PAPER NUMBER
----------	--------------

1646

DATE MAILED: 10/06/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/754,032

Applicant(s)

SCOTT ET AL.

Examiner

Janet L. Andres

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17 and 19, drawn to human patched and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.
- II. Claims 1-17 and 19, drawn to mouse patched and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.
- III. Claims 1, 3-17 and 19, drawn to mosquito patched and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.
- IV. Claims 1, 3-17 and 19, drawn to butterfly patched and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.
- V. Claims 1, 3-17 and 19, drawn to beetle patched and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.
- VI. Claim 18, drawn to methods of generic engineering using patched, classified in class 435, subclass 455.
- VII. Claims 20 and 21, drawn to screening methods using human patched, classified in class 435, subclass 7.1.

- VII. Claims 20 and 21, drawn to screening methods using mouse patched, classified in class 435, subclass 7.1.
- VIII. Claims 20 and 21, drawn to screening methods using mosquito patched, classified in class 435, subclass 7.1.
- IX. Claims 20 and 21, drawn to screening methods using butterfly patched, classified in class 435, subclass 7.1.
- X. Claims 20 and 21, drawn to screening methods using beetle patched, classified in class 435, subclass 7.1.
- XI. Claim 22, drawn to antibodies against human patched, classified in class 530, subclass 388.1.
- XII. Claim 22, drawn to antibodies against human patched, classified in class 530, subclass 388.1.
- XIII. Claim 22, drawn to antibodies against human patched, classified in class 530, subclass 388.1.
- XIV. Claim 22, drawn to antibodies against human patched, classified in class 530, subclass 388.1.
- XV. Claim 22, drawn to antibodies against human patched, classified in class 530, subclass 388.1.

Claims are included in more than one group if they encompass more than one invention.

The inventions are distinct, each from the other because of the following reasons:

The polynucleotides and cells of Groups I-V are distinct, each from the other, because they comprise different sequences with different structural and functional characteristics, requiring different searches.

The polynucleotides of Groups I-V are distinct from the methods of Group VI because they have other uses, such as protein expression.

The polynucleotides of Groups I-V are distinct from the methods of Groups VII-X because they have other uses, such as protein expression.

The polynucleotides of Groups I-V are not related to the antibodies of Groups XI-XV. They differ structurally and functionally and cannot be used together or interchangeably.

The methods of Group VI are not related to those of Groups VII-X. They require different method steps and have different goals and outcome measures.

The methods of Group VI are not related to the antibodies of Groups XI-XV. The antibodies cannot be used in the methods.

The methods of Groups VII-X are distinct, each from the other, because they require different reagents with different structural and functional characteristics, requiring different searches.

The methods of Groups VII-X are distinct from the antibodies of Groups XI-XV because the antibodies can be identified in different ways, such as by Western blotting, and the methods can be used to identify other agents.

The antibodies of Groups XI-XV are distinct, each from the other, because they are against different sequences with different structural and functional characteristics, requiring different searches.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the searches required for the different groups are different, restriction for examination purposes as indicated is proper.

Claim 1 link(s) inventions I-V. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claim 1. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Art Unit: 1646

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

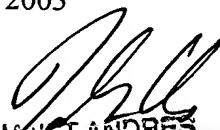
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Andres whose telephone number is 703-305-0557. The examiner can normally be reached on 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Janet L. Andres  
September 30, 2003

  
JANET ANDRES  
PATENT EXAMINER